



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,154	01/12/2006	Jeffrey Thomas Carter	118989-05072263	3341
20583	7590	03/30/2009	EXAMINER	
JONES DAY			GILLESPIE, BENJAMIN	
222 EAST 41ST ST			ART UNIT	PAPER NUMBER
NEW YORK, NY 10017			1796	
		MAIL DATE	DELIVERY MODE	
		03/30/2009	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

*Note*

1. Continuation of section 3: Applicants' amendments will not be entered after final because they raise new issues that were never previously considered. Specifically, claim 1 contains new limitations that require both (i) dimer and (ii) non-dimer fatty acids, wherein (i) and (ii) are present in amounts ranging from 60-100 and 0-40 wt% respectively. Additionally, claim 12 now requires the NCO content to be based on wt% of the total weight of adhesive.
2. Continuation of section 11: Applicants' arguments with respect to the rejection of
  - a) claims 12, and 14-19 under 35 U.S.C 112 1<sup>st</sup> paragraph, and
  - b) claims 1-30 under 35 U.S.C. 112 2<sup>nd</sup> paragraph,
3. Have been considered but are based on amendments that will not be entered after final.
4. Applicants also argue the claimed invention is not anticipated or rendered obvious by:
  - a) Saunders ('250)
  - b) Israel ('637), and
  - c) Trout ('232).
5. Because the prior art fails to explicitly teach the relied upon compositions useful as a "moisture curable adhesive".
6. In response, it is noted that the specific phrase "moisture curable adhesive" is never disclosed by references a), b), or c), however, each reference does in fact teach isocyanate-terminate prepolymers based on the reaction product of polyisocyanate and isocyanate-reactive material. It is basic knowledge within the polyurethane art that isocyanate-terminated prepolymers are reactive with moisture. Furthermore, said

prepolymers would exhibit adhesive strength to the extent limited by the breadth of claim 1 (claim set filed 7/25/2008).

7. Applicants' remarks stating "Saunders discloses reacting dimer fatty acids with an organic polyisocyanate, but does not disclose reacting a polyester polyol containing dimer with a polyisocyanate" have been noted, but this position is based on amendments which will not be entered.
8. Regarding applicants' arguments stating Israel and Trout do not teach adhesives since the final application is directed towards release properties, applicants are reminded that both Israel and Trout teach compositions that satisfy the limitations of claim 1 (claim set filed 7/25/2008). Claim 1 merely requires "a moisture-curable liquid adhesive" which the prior art would inherently satisfy to the extent limited by the breadth of the claim, i.e. any degree of adhesive strength.
9. Finally, applicants have not set forth any data establishing that the compositions of Israel and Trout would fail to exhibit some degree of adhesive strength, and instead merely rely on unsubstantiated opinions which can not be substituted for fact and therefore are not persuasive. *In re Pike et al.*, 84 USPQ 235; *In re Renstrom*, 81 USPQ 390.